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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/528,568

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Pierre Gerard Niewland

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EXAMINER

KURTZ, BENJAMIN M

ART UNIT

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1797

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/528,568	Applicant(s) NIEWLAND ET AL.	
	Examiner BENJAMIN KURTZ	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-17, 19, 22-24 and 29-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 11-17, 19, 22-24 and 29-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-10, 18, 20, 21 and 25-28 are cancelled and claims 11-17, 19, 22-24 and 29-35 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 1. Claims 11-17, 19, 22-24 and 29-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartels et al. US 6 110 365 in view of Hultgren US 3 233 737, Malecot et al. US 6 874 642 and/or applicant's admission.**

Claims 11 and 35, Bartels teaches a filtering device comprising: a filter part having a filtration filter (18) and a closure device (20) wherein the filter is substantially cylindrical and has axial end faces and also an interior space and wherein the closure member has a contact face sealingly engaging one of the axial end faces of the filter, a filter housing having both a main part (14) and a lid part (A), a clamping mechanism (screw threads between (9) and (11)), an inlet port (6) defined in the filter housing and situated outside the filter part, an outlet port (8) defined in the filter housing and in fluid

communication with the interior space of the filter and a spring member loaded between the filter part, in particular the closure member, and the filter housing (fig. 1). Bartels does not teach a micro-filtration filter or the closure member have a valveless open bore.

Hultgren teaches a filter having a closure member (14) having an open bore (19) defined therethrough enabling fluid to flow from an inlet port, through the bore into an interior space of a filter and out through an outlet port (fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a bore fluidly connecting the inlet to the outlet as taught by Hultgren because the bore allows leakage of fluid so fluid may pass when the filter media becomes clogged (col. 3, lines 3-10).

Bartels teaches a filter element but does not teach the filter element being a microfiltration element. Microfiltration filter element are very well known in the art as taught for instance in Malecot and by applicant's own admission and the references incorporated therein at paragraph [0003], page 3 of the specification. Applicant admits that it is generally known to use microfiltration for oil filters for improving efficiency. Therefore having a microfilter in place of an ordinary filter of the reference would be obvious. The claim would have been obvious because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention, *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (2007).

12, 14-17, 22, 23, 29 and 31-34 Bartels further teaches an oil passage closing face is integrated into the filter housing, the filter element is sealed against the housing and fluid does not leak (fig. 1); the filter has a diameter substantially equal to that of the filter part (fig. 1); the housing comprises a dimple (9) on its inner surface (fig. 1); the inlet port is positioned radially outside the filter part (fig. 1); the closure member includes a cylindrical notch that fits in the interior space of the filter part (fig. 1); the closure member contacts the inner surface of the filter housing by way of the spring (fig. 1); the filter part further has a perforated tube (19) lining the inner surface of the filter and defines the interior space of the filter (fig. 1); the inlet port is defined through the lid part of the filter housing (fig. 1); the filter part has a second closure member (11) that has a contact face sealingly engaging the other axial end face of the filter (fig. 1); the second closure member has an open bore defined therethrough enabling fluid to flow from the interior space of the filter, through the open bore and out through the outlet port (fig. 1); and the filter part further has an o-ring (5) mounted on the outer surface of the second closure member (fig. 1).

Claims 19, 24 and 30, Hultgren further teaches the open bore serves as a bypass mechanism (col. 3, lines 3-10); the open bore fluidly connects the interior space in the filter part to an in housing space that is exterior to the filter part (fig. 1); and the open bore is located in the center of the closure member (14). Bartels teaches the notch in the closure member is in the center of the closure member. One of ordinary skill in the art would recognize the bore would have to be in the center of the closure member of Bartels to properly connect the interior space with the inlet.

Claim 13, Bartels teaches the filter having a certain radial thickness but does not teach the radial thickness being greater than the radius of the interior space. The only difference between the prior art filter and the filter as claimed in a recitation of relative dimension. It would be obvious to one of ordinary skill in the art to reduce the radius of the interior space to save additional space in the overall housing as long as it would allow sufficient fluid to pass through the interior space. [W]here the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device, *Gardner v. TEC Systems, Inc.*, 220 USPQ 777 (1984).

Claims 11, 12, 14, 15, 17, 19, 22-24, 29-33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nieuwland US 6 536 600 in view of Hultgren US 3 233 737.

Claims 11 and 35, Nieuwland teaches a filtering device comprising: a filter part having a microfiltration filter (11) and also a closure member (9), wherein the filter is substantially cylindrical and has axial end faces and also an interior space, and wherein the closure member has a contact face sealingly engaging one of the axial end faces of the filter, a filter housing having both a main housing part (4) and a lid part (2), a clamping mechanism securing the lid part onto the main housing part, an inlet port (27) defined in the filter housing and situated outside the filter part, an outlet port (14)

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defined in the filter housing in fluid communication with the interior space of the filter and a spring (19) loaded between the closure member of the filter part and the filter housing (fig. 1). Nieuwland does not teach the closure member having a valveless open bore.

Hultgren teaches a filter having a closure member (14) having an open bore (19) defined therethrough enabling fluid to flow from an inlet port, through the bore into an interior space of a filter and out through an outlet port (fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a bore fluidly connecting the inlet to the outlet as taught by Hultgren because the bore allows leakage of fluid so fluid may pass when the filter media becomes clogged (col. 3, lines 3-10).

Claims 12, 14, 15, 17, 22, 23, 29 and 31-33, the limitations of these claims are further taught by Nieuwland.

Claims 19, 24 and 30, the limitations of these claims are further taught by Hultgren.

Response to Arguments

2. Applicant's arguments with respect to claim 11 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN KURTZ whose telephone number is (571)272-8211. The examiner can normally be reached on Monday through Friday 8:00am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Benjamin Kurtz
Examiner
Art Unit 1797

/BK/ 8/11/08

/Krishnan S Menon/
Primary Examiner, Art Unit 1797